

REMARKS

The Examiner's Office action of April 15, 2005 has been carefully reviewed. The Examiner first noted that Applicant submitted a list of references that did not comply with the requirements of 37 CFR 1.98)(a)(1). Applicant did this because the noted references had previously been considered by the Examiner in conjunction with the parent application, app. Ser. No. 10/038, 040 (now U.S. Pat. 6,659,967). Nonetheless, to overcome the Examiner's objections, Applicant hereby submits a new Information Disclosure Statement along with copies of the noted references.

Next, the Examiner objected to the "Cross Reference to Related Applications" insomuch as the current status of the parent application was not provided. Applicant has made the necessary amendments and the cross reference now specifically references U.S. Pat. 6,659,967 to Steinberg. This objection is, therefore, deemed overcome.

The Examiner then rejected claims 1 and 3 under 35 U.S.C. 102(b) as being anticipated by Iomoto, U.S. Pat. 5,879,312. Claim 6 was rejected under 35 U.S.C. 102(b) as being anticipated by Leonard, U.S. Pat. 6,063,044. Finally, the Examiner rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over Iomoto ('312) in view of Money, U.S. Pat. 5,224,469. Applicant traverses these rejections in view of the claim amendments and the arguments presented herein.

Claims 1 and 3 specify an apparatus that includes both an encoder for measuring the travel distance of the force probe and a load cell for use in measuring

the applied pressure. As noted in the amendments to the claims, both values are then used in computing a modulus hardness. This feature is neither taught nor suggested in Imoto ('312). Imoto ('312) only measures movement and not pressure. As noted in column 6, lines 12-16, although the use of a load cell is contemplated, it is only used as an alternative means for measuring movement. Imoto ('312) does not include a load cell for measuring applied pressures. In the absence of a force measurement, Imoto ('312) cannot determine hardness and, respectfully submitted, the Examiner's rejection should be withdrawn.

With regard to the Examiner's rejection of claim 6 as being anticipated by Leonard ('044), Applicant points out that claim 6 specifically recites that the "force probe has a solid cross section and an area that is substantially smaller than the cross section of the force plate." This construction is preferred because it minimizes the pain encountered in applying the instrument. Leonard ('044), by contrast, includes an enlarged cap (68) with a spring-like member (66) in its interior. This enlarged cap would inflict a greater degree of pain than the smaller force probe of Applicant's designs. In light of this limitation, Applicant urges reconsideration of the rejection based on Leonard (1044).

Next, the Examiner rejected claim 2 under U.S.C. 103(a) as being unpatentable over Imoto ('312) in view of Mocny ('469). Specifically, the Examiner relies upon the LED's (8) found in Mocny ('469) to modify the device of Imoto ('312). However, as stated above, Imoto ('312) fails to teach or suggest measuring applied pressure. Any combination of Mocny ('469) and Imoto ('312) would, therefore, still fail to meet the requirements of claim 2. Namely, although the modified device of

Imoto ('312) would contain LEDs, they would not indicate applied pressure. Further still, the warning LED's (8) of Mocny ('469) merely indicate whether "excessive pressure is being applied to [the] patient." See Mocny '469, Col. 4, Lines 25-30. Thus, the LED's of Mocny ('469) do not, and cannot, give an indication of the rate at which force is being applied as is recited in the subject claim. Consequently, Applicant respectfully requests reconsideration of the Examiner's rejection of claim 2.

Finally, claims 1 and 3-5 stand rejected under the judicially created doctrine of double patenting. Applicant submits herewith a terminal disclaimer which is sufficient to overcome the noted objection.

Accordingly, all grounds for objection and rejection are deemed overcome. Should any additional points remain, the Examiner can call the undersigned collect to discuss any of the issues addressed in this Amendment.

Respectfully submitted,

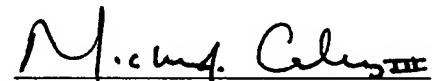


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CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing was placed in an envelope and mailed via first class mail, postage paid, to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 7th day of September, 2005.

The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account Number 50-1667.


Michael J. Colitz, III

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DATE OF DEPOSIT: 9/07/05

I HEREBY CERTIFY that the enclosed Transmittal Form; Fee Transmittal Form; Request for Two Month Extension of Time; Amendment A; Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior" Patent; Credit Card Payment Form; and return receipt postcard are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, postage prepaid, on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 .

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